

REMARKS

Applicants respectfully request reconsideration of this application in view of the following remarks. Claims 48, 53-55, 84, 86-88, and 116 have been amended and claims 56 and 89 have been cancelled. Claims 48-50, 53-55, 57-88, and 90-126 remain pending in the application, with claims 48, 84, and 116 being independent claims. A petition for a one-month extension of time along with the requisite fee of \$110.00 is being submitted with this amendment. It is believed no other fees are due. However, if additional fees are due, the Commissioner is authorized to charge such fees to Deposit Account No. 13-2855.

Claims 53-56 and 86-89 stand rejected under 35 U.S.C. § 112 first and second paragraphs. The Examiner asserts that the specification, while being enabling for providing a ticket when a player has lost a number of games is not enabling for providing a ticket when a player has lost a number of games while at the same time not providing a ticket based on the cumulative result of a plurality of outcomes. Applicant has amended claims 48 and 84 to more particularly recite that the triggering event, *inter alia*, is not a cumulative result of a plurality of winning outcomes. The dependent claims are directed to dispensing tickets in response to the triggering event based at least in part on non-winning outcomes, and in some claims a predetermined number of non-winning outcomes. Applicants respectfully submit that the limitations of claims 48 and 84 as amended reciting that the triggering event is not based on the cumulative result of winning outcomes is not inconsistent with triggering events based on non-winning outcomes as recited in the dependent claims, and respectfully request withdrawal of the rejections under 35 U.S.C. § 112.

Claims 48-50, 59-63, 78-84, 92-97, and 111-122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* (U.S. Patent No. 5,816,918) in view of Deaton *et al.* (U.S. Patent No. 5,621,812). Claims 57, 58, 90, and 91 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Deaton as applied to claims 48 or 84, and further in view of Harlick (U.S. Patent No. 5,941,773). Claims 64 and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Deaton as applied to claims 48 and 84, and further in view of Harrison (U.S. Patent No. 5,934,671). Claims 65, 66, and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48, and further in view of Baerlocher *et al.* (U.S. Patent No. 5,788,573). Claims 67-77 and 100-110 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Kelly and Deaton as applied to claims 48, and further in view Mullins (U.S. Patent No. 5,158,293). Claims 123-126 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly and Deaton as applied to claims 116, and further in view Boushy (U.S. Patent No. 5,761,647). Reconsideration is respectfully requested.

Regarding claims 48-50, 53-55 and 57-83, claim 48 recites, *inter alia*, a first output device adapted to dispense a gaming award and a second output device adapted to dispense a ticket that is *not* a gaming award after the occurrence of a triggering event, wherein the triggering event is *not* an occurrence of a winning outcome of the wagering game or a cumulative result of a plurality of winning outcomes of the wagering game, and wherein the triggering event is *not* every occurrence of the wagering game. Kelly *et al.* does not teach these limitations and, therefore, does not anticipate or render obvious the present invention as recited in claim 48. First, Kelly *et al.* only discloses dispensing tickets that are gaming awards. Kelly *et al.* discloses a universal ticket dispenser and a specific ticket dispenser that can dispense tickets based on a player achieving a predetermined goal or task during the game. See Kelly *et al.*, column 8, lines 25-32. Kelly *et al.* further teaches that each of the tickets dispensed by the dispensers 20 and 22 are equal to one prize credit accumulated by the player during the game. Kelly *et al.*, column 8, line 49. In column 9, line 21, Kelly *et al.* states that the amount of the universal ticket dispensed to the player is typically based upon a game score or other result of a game process. In addition, special progressive goals may be achieved by the player to win addition or specified number of tickets. Continuing in column 9, line 46, a specific prize or instant prize can be dispensed from a specific prize ticket dispenser wherein a particular prize or type of prize that a player can directly and immediately be awarded, and in most cases immediately received due to a particular winning result on a game. Thus, Kelly *et al.* dispenses gaming awards in the form of tickets, and does not disclose or suggest either dispensing tickets that are not gaming awards, or dispensing tickets after a triggering event that is not the occurrence of a winning outcome or a cumulative result of a plurality of winning outcomes. For at least these reasons, Kelly *et al.* does not anticipate or render obvious claims 48-50, 53-55 and 57-83.

The Deaton *et al.* reference does not provide the necessary disclosure missing from Kelly *et al.* Deaton *et al.* teaches a marketing system for grocery stores that collects customer information and prints coupons for the customer at the check out line. Deaton *et al.*

does not disclose or suggest dispensing a ticket that is not a gaming award from a gaming unit and, therefore, does not anticipate or render obvious claims 48-50, 53-55 and 57-83. Furthermore, Kelly *et al.* and Deaton *et al.* together fail to teach or suggest dispensing a ticket that is not a gaming award from a gaming unit and therefore, because this limitation of the claims is missing from the references, the combination does not anticipate or render obvious claims 48-50, 53-55 and 57-83.

Even assuming, *arguendo*, that the references teach dispensing a ticket from a gaming unit that is not a gaming award, the Kelly *et al.* and Deaton *et al.* references provide no suggestion or motivation to be combined in the manner proposed by the Examiner to arrive at the invention of claim 48. The prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Merely stating integration of the claimed elements is obvious is not the same as “show[ing] a motivation to combine the references.” In order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Furthermore, the mere fact that references can be modified is not sufficient to establish *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)” (emphasis original). The suggestion to combine references must be from the prior art, not the Applicants’ disclosure. See Section 2143 of the M.P.E.P., which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).”

As discussed above, Kelly *et al.* provides no suggestion or motivation for dispensing tickets that are not gaming awards from a gaming unit. Further, Kelly *et al.* does

not suggest or provide motivation for looking to retail marketing and customer check-out systems such as Deaton *et al.* for any reason, let alone for dispensing tickets from a gaming unit. Conversely, Deaton *et al.* provides no suggestion or motivation for implementing its coupon printing system in a gaming unit which, *inter alia*, does not collect information regarding customer purchases which is necessary for generating the coupons in the Deaton *et al.* system.

The Examiner asserts that a person skilled in the art would be motivated to combine Kelly *et al.* and Deaton *et al.* to issue non-gaming award tickets to encourage players to return to the gaming location. However, there is no actual evidence of such motivation or suggestion in the references to combine them in the proposed manner to achieve the claimed invention. The only motivation for the claimed invention is provided by the Applicants' own specification, the use of which constitutes impermissible hindsight analysis. Because there is no clear and particular suggestion or incentive to combine the references in the manner proposed by the Examiner based on actual evidence, it follows that the Kelly *et al.* and Deaton *et al.* references do not render claims 48-50, 53-55, and 57-83 obvious.

Claims 84-88 and 90-115 recite methods for conducting a wagering game wherein tickets that are not gaming awards are dispensed in response to triggering events in a similar manner as recited in apparatus claims 48-50, 53-55 and 57-83. For similar reasons as discussed above with respect to claim 48, the combination of Kelly *et al.* in view of Deaton *et al.* does not anticipate or render obvious claims 84-88 and 90-115.

Regarding claim 116, claim 116 involves a method of conducting a wagering game on an electronic gaming device that requires, *inter alia*, accumulating comp points for the player as the player plays the wagering game wherein the comp points are determined *independent* of the outcome of the randomly determined wagering game and the skill of the player. Kelly *et al.* provides credits/award tickets based on winning outcomes. Kelly *et al.* teaches awards that are directly *dependent* on the outcome of the game. As discussed above Kelly *et al.* does not dispense anything other than gaming awards and therefore does not anticipate or render obvious the invention as recited in claim 116. The Examiner asserts that Deaton *et al.* teaches comp points (i.e., discount coupons) based on the frequency of business

by a patron and that it would have been obvious to one of ordinary skill to modify Kelly *et al.* in view of Deaton *et al.* to award comp points that are not determined by the outcome of the randomly determined wagering game or the skill of the player in order to increase the frequency of customer visits. As further discussed above and for the same reasons, Kelly *et al.* and Deaton *et al.* are not properly combinable to yield a method for conducting a wagering game wherein comp points or tickets that are not gaming awards are dispensed by a gaming unit. Therefore, the combination of Kelly *et al.* and Deaton *et al.* fail to disclose or suggest the invention as recited in claim 116. Furthermore, as stated earlier, Deaton *et al.* is not analogous art. Deaton *et al.*, as described above, teaches a method for marketing in response to customer shopping history. One skilled in the art of wagering games would not look to marketing methods for inducing shoppers to shop at retail outlets when approaching a problem in the gaming industry. Claims 117-126 depend from claim 116 and are likewise submitted to be in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections are respectfully requested.

It is respectfully submitted that this response traverses and overcomes all of the Examiner's objections and rejections to the application as originally filed. Reconsideration of the application is requested. It is respectfully submitted that the application is in suitable condition for allowance; notice of which is requested.

If the Examiner feels that prosecution of this present application can be expedited by way of an Examiner's amendment or further communication, the Examiner is invited to contact the applicant's attorney at the telephone number listed below.

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Respectfully submitted,

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